

REMARKS

Re-examination of the above mentioned application is hereby requested in view of the arguments which follow. Applicants appreciate the Examiner's thorough consideration of the above-identified application, and in the Examiner's recognition of allowable subject matter. In response to the Examiner's request, Applicants submit the following arguments.

The Examiner has changed his rejection of claim 1 from the previous response, from a rejection under 35 U.S.C. § 103a as being unpatentable over Kosmala (U.S. Patent 5,645,454) in view of Suzuki, et al. (U.S. Patent 5,011,415), to the present rejection under 35 U.S.C. § 102(b) in light of Kosmala.

The Examiner indicated that in regards to claims 1-3 and 17, that Kosmala discloses a shielded jack assembly comprising:

- An insulator member (14) having pin receiving passageway, a rear slot intersecting the passageway at least to an outer surface of the insulator;
- A pin (12) having an elongate portion (20) and an orthogonally arranged PCB tine (22) which extends in the rear slot, the pin having a mating portion extending into the recess portion, where the pin is exposed;
- A shielded tube (36) extending at least partially along a length of the insulator member; and
- A metallic shell (38) having an outer body (44) conforming to an exterior contour of the shielded tube, sidewall portions (52) and a rear plate portion (56) hingedly connected to the outer body and folded downwardly to enclose an end opening.

Applicants respectfully reject this interpretation, and submit that Kosmala does not anticipate claims 1-3 and 17, and therefore cannot be rejected on the basis of 35 U.S.C. § 102(b). The examiner himself has indicated that some features are not present. The examiner has indicated that that Kosmala shows "A shielded tube (36) extending at least partially along a length of the insulator member and a metallic shell (38) having an outer body (44) conforming to an exterior contour of the shielded tube, sidewall portions (52)

and a rear plate portion (56) hingedly connected to the outer body and folded downwardly to enclose an end opening".

What the Examiner did not say, **and cannot say**, is that Kosmala teaches:

- an elongate **seamless** shielded tube extending from a position adjacent said front end of said insulator, and rearwardly, at least partially along the length of said insulator member, and
 - a **stamped and formed metallic ground shell**, having an outer body portion conforming to an exterior contour of said shielded tube, sidewall portions extending downwardly therefrom with integrally formed printed circuit board portions, and a rear plate portion hingedly connected to said outer body portion, and folded downwardly to enclose an end opening".
- The reason that the Examiner cannot say this is because Kosmala does not have such a structure.

Rather, Kosmala specifically teaches having a housing (38) which is die cast and a shielding tube having a seam (See Figure 5). Die casting is very expensive and is contradictory to the present invention. Rather, Applicants have provided an elongate seamless shielded tube in combination with a stamped and formed metallic ground shell. Kosmala teaches just the opposite having a seamed tube or shell (36) and zinc alloy die cast housing (38).

"Federal Circuit decisions repeatedly emphasize that anticipation (lack of novelty) is established only if (1) all the elements of an invention, as stated in a patent claim, (2) are identically set forth, (3) in a single prior art reference." *Chisum on Patents*, Donald S. Chisum, Vol. 1 §3.02[1][b] at 12-14 (*citations omitted*). In addition, "[f]or a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 1473, 43 U.S.P.Q.2d 1481, 1490 (Fed. Cir. 1997) (*citing In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)).

As each and every element of claim 1 is not found in Kosmala, the claim is not anticipated by it. Thus, Kosmala simply cannot, under current Federal Circuit law, as mentioned above, anticipate Applicants' invention.

Furthermore, the Examiner rejected claims 5-7, 10-11, 18 and 20 under 35 U.S.C. § 103a as being unpatentable over Kosmala in view of Regnier (U.S. Patent 6,575,761). The Examiner indicated that Kosmala discloses the present invention as claimed with the exception of the outer shroud portion. However, the Examiner points to Regnier Fig. 7, indicating that Regnier has a housing (16) and that it would have been obvious to one of ordinary skill at the time the invention was made to provide Kosmala to have the housing as taught by Regnier in order to protect the shielded tube.

The Examiner is simply picking and choosing elements in order to find the combination. In the last rejection, the examiner called the front shield portions 14 the shroud. Now the Examiner refers to the housing 16 of Regnier as the shroud. Applicants believe that neither is properly characterized as a shroud. Applicants in claim 5, indicate that the jack assembly further comprises "an outer shroud portion surrounding said shielded tube, forming an outer shielding." The housing 16 cannot fulfill this limitation for at least two reasons. First, the housing is comprised of overmolded plastic and could not possibly form shielding (See Column 3, lines 5-7). Second, plastic housing 16 does not surround the shielded tube. As shown in Figure 1, housing 16 abuts grounding clip 18, and thus never is even adjacent to the shielded tube. Thus, the obviousness rejection cannot stand.

Finally, the Examiner rejected claims 4, 12-13, and 19 under 35 U.S.C. § 103a as being unpatentable over Kosmala and Regnier as applied to claims 1 and 10 above and further in view of Skopic, et al. (U.S. Patent 6,386,888). Skopic shows a conductive insert (92) having a circumferentially extending groove (176) and further indicates that the shell of the female contact will mate with the groove (176) in a conventional manner.

Claims 4, 12-13, and 19 indicated that the shielded tube is provided with a peripheral undercut and that the ground shell is crimped around the tube with a section of the outer body portion extending into the undercut. Thus the undercut in Skopic relates to

a temporary mating connection whereas the undercut in the present application relates to the permanent crimping of the two parts together of the same component. This is contrary to the teaching of Skopic.

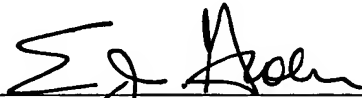
CONCLUSION

Applicants believe that the application, as presently presented, is now in condition for allowance and action toward that end is respectfully requested. If any issues remain that can be resolved by telephone, the Examiner is invited to call the undersigned attorney.

In the event that Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefore and authorize that any charges be made to Deposit Account No. 02-0390, BAKER & DANIELS.

Respectfully Submitted,

By:

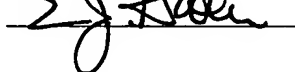


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